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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/842,361	04/25/2001	Robert Hess	2119/103	6579
2101	7590	05/17/2005	EXAMINER	
BROMBERG & SUNSTEIN LLP 125 SUMMER STREET BOSTON, MA 02110-1618			SNAY, JEFFREY R	
		ART UNIT	PAPER NUMBER	
		1743		

DATE MAILED: 05/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

JW

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/842,361	HESS ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jeffrey R. Snay	1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 24 February 2005.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 9-44 and 131 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 9-44 is/are rejected.
- 7) Claim(s) 131 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date: _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/28/01, 9/23/02, 10/21/02</u> | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election without traverse of claims 9-44 in the reply filed on 02/24/05 is acknowledged.

***Claim Objections***

2. Claim 131 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim must refer to pertinent parent claims in the alternative only. See MPEP § 608.01(n). Accordingly, the claim 131 has not been further treated on the merits.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 9-44 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 9-44 recited, as a method step, "tracking each droplet's position." This step is not sufficiently enabled by the specification such that one of ordinary skill in the

art could practice the claimed method. Specifically, the specification teaches the presence of a "drop tracker" which "may be responsible for triggering the reagent dispensing task" (page 31, lines 9-11). Thus the specification teaches an element which applicant's refers to as a "tracker" but which provides a function of triggering. The specification further teaches the provision of "drop sensors" and a "rotary encoder" which are utilized to provide a "fiduciary position" for each droplet on the belt (page 31, last paragraph). However, the specification fails to adequately explain how a combination of drop sensors, and a rotary encoder would accomplish the recited step of tracking.

Because the specification fails to provide and special definition for the term "tracking," the examiner must resort to the common dictionary definition of the term. Webster's Collegiate Dictionary, 10th edition, provides the definition as "to observe or plot the moving path of instrumentally." The specification teaches only the provision of drop sensors which appear to indicate the presence or absence of a drop at a given station. A rotary encoder, which itself is undefined by the specification, appears to provide some indication of the position of a dispenser with respect to the belt. In light of the common definition of tracking, the claimed step of tracking each droplets position would require some identifying feature specific for each individual droplet, combined with means for identifying the spatial position of each individual droplet, independent of all other droplets, as the belt is moved. The specification fails to enable one of ordinary skill in the art how this claimed step would be accomplished.

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure to the extent that it teaches performing various functions on moving droplets, or alternatively, to the extent that it teaches instrumentally plotting or calculating the location of a sample as it moves through spatial coordinates.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey R. Snay whose telephone number is (571) 272-1264. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill A. Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey R. Snay  
Primary Examiner  
Art Unit 1743

jrs